

William H. Swain

Serial Number 08/579,395

Prior Art Unit: 2213

Patent and Trademark Office  
Commissioner of Patents and Trademarks  
Washington, DC 20231

25 May 1999

GP-2213

Subject:  
Alleged informality dated 19 May 99  
Payment of fee \$1,576.00 from  
Clerk of Group Darlene Y. Brown  
Sect 2800  
703-208-5852

Letter  
# 18

6-11-99

Re:  
William H. Swain, inventor  
Error Correction by Selective Modulation  
SN 08/579,395; Filed 12/27/95; Art 2213  
Group 2858  
703-308-5222, or 305-4900  
Primary Examiner: Mr. Ernest F. Karlsen

T. Flowers

Greetings;

Applicant holds that the Clerk of Group is incorrect in billing applicant for \$1,576.00.

Firstly, applicant and his employer are both small entity, so the charge should not exceed half of \$1,576.00, i.e., \$788.00.

Secondly, applicant did **NOT** file an amendment. On the contrary, applicant's response of 12 March 99 included the same, identically worded claims. They were, reluctantly, given new numbers in response to the examiner's second request to so do.

A more detailed traverse follows.

Applicant telephoned the Clerk of Group at the number given, but was unsuccessful in reaching any person.

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1) The Clerk of Group's notice of 19 May 99 (enclosed exhibit A) requires payment of \$1,576.00. Basis included is "...Fee determination..." (enclosed exhibit B.) Calculation is under "other than small entity." This does not apply to applicant.

Applicant's employer, the William H. Swain Co. was and is a small entity as shown in enclosed 1995 exhibit C. Applicant is also a small entity as shown on enclosed 1995 exhibit D. Therefore, the maximum fee to be charged would be \$788.00, if indeed any fee were due, which it is not, as shown in 2) below.

2) Applicant's response of 12 March 99 begins on page 1 (Exhibit E enclosed.) "Paragraph 1 concerns NEW NUMBERED claims 32 through 62. They are listed in Table 1. THIS IS IN GENERAL ACCORD WITH THE EXAMINER'S SUGGESTION." (Emphasis added.)

The claims are not new - they are not even reworded. The claims 32 through 62 are identically worded with the prior claims 1 through 31, save only reference number fit.

Paragraph 1) on page 3 of 12 March 99 (Exhibit F) says the same with different words. Please note: These are "...new number claims 32 thru 62..." They are "...verbatim copies of claims 1 thru 31..." New numbering is done "In accord with the Examiner's suggestion...", and "...with the proviso that ...no added cost to applicant...".

The examiner's request of 28 Jan 99, paragraph 1, page 2 (Exhibit G enclosed) makes it clear that new numbering was done for the convenience of the patent office. He says: "It is suggested...and the claims be presented as claim 32 to whatever...". "Claims...can be copied verbatim and given NEW NUMBERS." (Emphasis added.)

Applicant reluctantly did this. What was done is new numbering. "Amendment" was NOT made. Therefore, no fee is warranted.

Applicant felt pressure from the examiner to use "new numbers" because there was also a previous request: The action of 22 Sept. 1998, page 2, paragraph 2 (Exhibit H enclosed.) The examiner wrote "It is suggested...copied verbatim and given new numbers."

Applicant was then reluctant to do this so asked that "...the present numbering...be continued..." in his 4 Nov 98 response - page 1, last paragraph. (Exhibit I enclosed.)

Apparently, there was basis for reluctance.

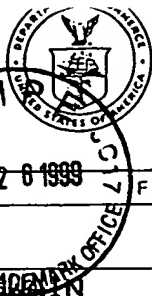
#### Summary

It is clear that applicant did not want to use "new numbers". Also, the examiner twice asked that applicant use "new numbers". So the "new numbers" were for the convenience of the Patent Office. Therefore, no fee is indicated, especially since there was no amendment.

Applicant looks forward to receiving notice that no fee is due, hopefully well before the 19 June 99 deadline stated in Exhibit A.

*William H. Swain*  
5-25-99

-A



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/579.395	12/27/95		

WILLIAM H SWAIN  
4662 GLEASON AVE  
SARASOTA FL 34242

MM51/0519

EXAMINER	
KARLSEN, E	PAPER NUMBER
	17

DATE MAILED:  
2858

05/19/99

INFORMALITY RE PAYMENT OF FEE

The informality regarding the payment of the fee in connection with ☐ the original filing fee ☐ the amendment filed \_\_\_\_\_ is indicated below.

A. FEE DUE

1. ☐ The amendment is considered incomplete in that the funds in Deposit Account No. \_\_\_\_\_ are insufficient to cover the entire fee due. The balance is due within the period set below.
2. ☐ The amendment is considered an incomplete response, in that payment of \$ \_\_\_\_\_ is insufficient to cover the claims as shown in the attached Patent Application Fee Determination Record. Remittance is due within the period set below.
3. ☒ The amendment has not been entered, since applicant has failed to remit (or authorize charge to a Deposit Account) the fee as indicated on the attached Patent Application Fee Determination Record. Remittance or authorization is due within the period set below.

4. ☐ The filing fee of \$ \_\_\_\_\_ submitted in this application is insufficient.

A balance of \$ \_\_\_\_\_ is due for additional claims.

5. ☒

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APPLICANT IS GIVEN THE REMAINDER OF THE SET PERIOD FOR RESPONSE,  
OR ONE (1) MONTH FROM THE DATE OF THIS LETTER, WHICHEVER IS LONGER,  
WITHIN WHICH TO REMIT THE FEE OF \$21,576.00.

B. EXCESS PAYMENT:

5. ☐ It is noted that payment of \$ \_\_\_\_\_ is in excess of the amount necessary to cover the claims now in the application. See the attached Patent Application Fee Determination Record.

This matter of refund or credit to your account is being referred to the Finance Officer, for his consideration.

*Deborah Y Brown*  
CLERK OF GROUP

Slctu 2800

703-218-5852

# PATENT APPLICATION FEE DETERMINATION RECORD

Effective November 10, 1998

Application or Docket Number

08/579395

## CLAIMS AS FILED - PART I

(Column 1)

(Column 2)

SMALL ENTITY TYPE ☐ OR

OTHER THAN SMALL ENTITY

FOR	NUMBER FILED	NUMBER EXTRA
BASIC FEE		
TOTAL CLAIMS	minus 20 = *	
INDEPENDENT CLAIMS	minus 3 = *	
MULTIPLE DEPENDENT CLAIM PRESENT		

RATE	FEE		RATE	FEE
	380.00	OR		760.00
X\$ 9=		OR	X\$18=	
X39=		OR	X78=	
+130=		OR	+260=	
TOTAL		OR	TOTAL	

\* If the difference in column 1 is less than zero, enter "0" in column 2

## CLAIMS AS AMENDED - PART II

(Column 1)

(Column 2)

(Column 3)

SMALL ENTITY OR

OTHER THAN SMALL ENTITY

AMENDMENT A	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA
Total	* 62	Minus	** 31	= 31
Independent	* 27	Minus	*** 14	= 13
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM				

RATE	ADDITIONAL FEE		RATE	ADDITIONAL FEE
X\$ 9=		OR	X\$18=	558.00
X39=		OR	X78=	1018.00
+130=		OR	+260=	
TOTAL ADDIT. FEE		OR	TOTAL ADDIT. FEE	1576.00

(Column 1)

(Column 2)

(Column 3)

RATE	ADDITIONAL FEE		RATE	ADDITIONAL FEE
X\$ 9=		OR	X\$18=	
X39=		OR	X78=	
+130=		OR	+260=	
TOTAL ADDIT. FEE		OR	TOTAL ADDIT. FEE	

AMENDMENT B

CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA
Total	*	Minus **	=
Independent	*	Minus ***	=
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM			

(Column 1)

(Column 2)

(Column 3)

RATE	ADDITIONAL FEE		RATE	ADDITIONAL FEE
X\$ 9=		OR	X\$18=	
X39=		OR	X78=	
+130=		OR	+260=	
TOTAL ADDIT. FEE		OR	TOTAL ADDIT. FEE	

AMENDMENT C

CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA
Total	*	Minus **	=
Independent	*	Minus ***	=
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM			

- \* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.
- \*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20."
- \*\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3."

The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.

**VERIFIED STATEMENT CLAIMING SMALL ENTITY STATUS**  
(37 CFR 1.9(f) & 1.27(c))--SMALL BUSINESS CONCERN

Doclet Number (Optional)

MAY 26 1999

Applicant or Patentee: William H. Swain

Serial or Patent No.: \_\_\_\_\_

Filed or Issued: \_\_\_\_\_

Title: Error Correction by Selective Modulation

I hereby declare that I am

☐ the owner of the small business concern identified below:

☒ an official of the small business concern empowered to act on behalf of the concern identified below:

NAME OF SMALL BUSINESS CONCERN William H. Swain Co.

ADDRESS OF SMALL BUSINESS CONCERN 239 FIELD END ST  
SARASOTA FL 34240

Phone: 813-957-3110

I hereby declare that the above identified small business concern qualifies as a small business concern as defined in 13 CFR 121.12, and reproduced in 37 CFR 1.9(d), for purposes of paying reduced fees to the United States Patent and Trademark Office, in that the number of employees of the concern, including those of its affiliates, does not exceed 500 persons. For purposes of this statement, (1) the number of employees of the business concern is the average over the previous fiscal year of the concern of the persons employed on a full-time, part-time or temporary basis during each of the pay periods of the fiscal year, and (2) concerns are affiliates of each other when either, directly or indirectly, one concern controls or has the power to control the other, or a third party or parties controls or has the power to control both.

I hereby declare that rights under contract or law have been conveyed to and remain with the small business concern identified above with regard to the invention described in:

- ☒ the specification filed herewith with title as listed above.  
☐ the application identified above.  
☐ the patent identified above.

If the rights held by the above identified small business concern are not exclusive, each individual, concern or organization having rights in the invention must file separate verified statements averring to their status as small entities, and no rights to the invention are held by any person, other than the inventor, who would not qualify as an independent inventor under 37 CFR 1.9(c) if that person made the invention, or by any concern which would not qualify as a small business concern under 37 CFR 1.9(d), or a nonprofit organization under 37 CFR 1.9(e).

Each person, concern or organization having any rights in the invention is listed below:

- ☐ no such person, concern, or organization exists.  
☒ each such person, concern or organization is listed below.

4662 Gleason Ave.  
Sarasota, FL 34242

Phone: 813-349-4593

Separate verified statements are required from each named person, concern or organization having rights to the invention averring to their status as small entities. (37 CFR 1.27)

I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate. (37 CFR 1.28(b))

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

NAME OF PERSON SIGNING William H. Swain

TITLE OF PERSON IF OTHER THAN OWNER President

ADDRESS OF PERSON SIGNING 4662 Gleason Ave. - Sarasota, FL 34242

SIGNATURE William H. Swain

DATE 21 December 1995

**VERIFIED STATEMENT CLAIMING SMALL ENTITY STATUS**  
(37 CFR 1.9(f) & 1.27(b))--INDEPENDENT INVENTOR

Docket Number (Optional)

Applicant or Patentee:

William H. Swain

Serial or Patent No.:

Filed or Issued:

Title:

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As a below named inventor, I hereby declare that I qualify as an independent inventor as defined in 37 CFR 1.9(c) for purposes of paying reduced fees to the Patent and Trademark Office described in:

- ☒ the specification filed herewith with title as listed above.  
☐ the application identified above.  
☐ the patent identified above.

I have not assigned, granted, conveyed or licensed and am under no obligation under contract or law to assign, grant, convey or license, any rights in the invention to any person who would not qualify as an independent inventor under 37 CFR 1.9(c) if that person had made the invention, or to any concern which would not qualify as a small business concern under 37 CFR 1.9(d) or a nonprofit organization under 37 CFR 1.9(e).

Each person, concern or organization to which I have assigned, granted, conveyed, or licensed or am under an obligation under contract or law to assign, grant, convey, or license any rights in the invention is listed below:

- ☐ No such person, concern, or organization exists.  
☒ Each such person, concern or organization is listed below.

William H. Swain Co.  
239 Field End St.  
Sarasota, FL 34240

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MAY 27 1999  
TECHNOLOGY CENTER 2800

Phone:  
813-  
957-  
3110

Separate verified statements are required from each named person, concern or organization having rights to the invention availing to their status as small entities. (37 CFR 1.27)

I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate. (37 CFR 1.28(b))

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

William H. Swain - Sole Inventor

NAME OF INVENTOR

NAME OF INVENTOR

NAME OF INVENTOR

William H. Swain

Signature of inventor

Signature of inventor

Signature of inventor

21 December 1999

Date

Date

Date

William H. Swain

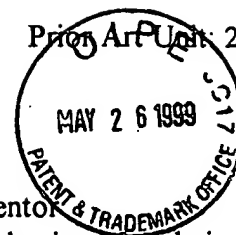
Serial Number 08/579,395

Priority Art Unit: 2213

Patent and Trademark Office  
Commissioner of Patents and Trademarks  
Washington, DC 20231

March 08, 1999

Re:  
William H. Swain, inventor  
Error Correction by Selective Modulation  
SN 08/579,395; Filed 12/27/95; Art 2213  
Group 2858  
703-308-5222, or 305-4900  
Primary Examiner: Mr. Ernest F. Karlsen



Subject:

Reply to the Action of 20 Jan. 1999.

Introduction

This reply is in response to Primary Examiner Karlsen's action mailed 28 January 1999. Applicant first outlines the contents of this reply, and then responds fully to every aspect of the Examiner's Action.

*William H. Swain*  
*12 March 1999*

a) Claims

Paragraph 1 concerns new numbered claims 32 through 62. They are listed in table 1. This is in general accord with the Examiners suggestion.

Applicant holds that he has particularly pointed out and distinctly claimed the subject matter which he regards as the invention. However, since it is not clear to the examiner..., this response includes several items aimed at clarity and ease of understanding. The examiner's suggestion, re MPEP 706, for overcoming defects in the claims, will be welcomed by Applicant.

b) Clarity of claims:

Paragraph 2 includes, in response to the Examiners request, a new reading of each of the independent claims with respect to a figure of the drawings. And also with respect to the description.<sup>1</sup> Paragraph 2.SR.32 shows explicit, and also implied antecedent basis for new number claim 32.



g) Previous claim readings

A detailed reading of each independent claim appears in paragraphs 3.1 thru 3.31 of my last response, dated 5 Nov 98. This is included in this response by reference. An exception is old number claim 15. This new number claim 46 is now seen to be subgenus apparatus. I explain in paragraph 2.SR.46.

h) All claims fully stated herein

Each of claims 32 thru 62 is fully stated - a verbatim copy of old claims 1 thru 31, in par. <sup>h)</sup> at the end of this response, *P. 77 thru P. 104, incl.*

1. New Number Claims

In accord with the Examiner's suggestion I enclose new number claims 32 through 62. These are verbatim copies of the claims 1 through 31 in my response filed 5 Nov 98, paragraph 11. Table 1 is a summary of the claim numbering. This is done with the proviso that these claims 32 through 62 become a part of my application at no added cost to. Applicant will not object if the Examiner cancels old claims 1 through 31, along with any others he may believe are currently in the Application.

The new number claims are fully stated at the end of this response. Paragraph # h.32 includes a statement of new number claim 32 which is verbatim the same as my old number claim 1, etc. The exceptions are references in dependent claims which use the new number. And so on, to claim new number 62 which is in paragraph # h.62 and is verbatim the same as old number claim 31.

Table 1 Claim Numbers

Old number Claim	New number Claim	Applicant		
		Genus	Species	Type
1	32	45	Comb	PM
2	33	45	Comb	PM
3	34	45	Comb	PM
4	35	61	Comb	PM
5	36	61	Comb	PM

2-12-99

-G-

28 Jan. 99  
Page 2

Application/Control Number: 08/579,395

Art Unit: 2858

1. Applicant has added numerous claims in response to Office Actions and has given claims strange numbers. Which claims are in the case and exactly what their numbers are is not clear. It is suggested that all the claims presently in the case be cancelled and the claims be presented as claim 32 to whatever the highest number is. Claims cannot be renumbered under the rules but they can be copied verbatim and given new numbers. See 37 CFR 1.26. Claims 1-31 and others seem to currently be in the application.

2. Claims 1-31 and any other claims that might be in the application are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what all the claimed elements and steps are and it is not clear how they are interconnected and interrelated to produce the desired results. It is requested that a reading of each of the independent claims be provided with respect to a figure or figures of the drawings. Claim 14, for instance, has no positively claimed elements and appears to be kind of a statement of a law which in itself is not clear. It is not clear in claim 14 what parts make up a sensor.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

4. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

-H-

9/22/98  
Page 2

Art Unit: 2858

1. Because Applicant has indicated that no patentably distinct inventions<sup>or</sup> species are present the Restriction Requirements of February 21, 1997 and January 16, 1998 are withdrawn. It is noted that Applicant states on page 1 (actually the second page) of the Amendment of May 29, 1997: "My traverse relies on the fact that the basic concept (claim 14) is in every claim, so no claim would be patentable over another because it would lack novelty outside of this application."

2. Applicant has added numerous claims in response in response to restriction requirements and has given claims strange numbers. Which claims are in the case and exactly what their numbers are <sup>is not</sup> ~~are not~~ clear. It is suggested that all the claims presently in the case be cancelled and the claims represented as claims 32 to whatever the highest number is. Claims cannot be renumbered under the rules but they can be copied verbatim and given new numbers. See 37 CFR 1.26. Claims 1-31 seem to currently be in the application.

3. Claims 1-31 and any other claims that might be in the application are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what all the claimed elements and steps are and it is not clear how they are interconnected or interrelated to produce the desired results. It is requested that a reading of each of the independent claims be provided with respect to a figure or figures of the drawings. Claim 14, for instance, has no positively claimed elements and appears to be kind of a statement of a physical law which in itself is not clear.

William H. Swain

Serial Number 08/579,395

Prior Art Unit: 2213

Patent and Trademark Office  
Commissioner of Patents and Trademarks  
Washington, DC 20231

October 28, 1998

Re:  
William H. Swain, inventor  
Error Correction by Selective Modulation  
SN 08/579,395; Filed 12/27/95; Art 2213  
Group 2858  
703-308-5222, or 305-4900  
Primary Examiner: Mr. Ernest F. Karlson

Subject:

Reply to the Action of 22 Sept. 1998.

1) Introduction:

This response generally follows the examiner's action of 22 Sept. 1998.

*William H. Swain*  
*4 Nov. 98*

Applicant is pleased that the restriction requirements are withdrawn. This is appreciated. The examiner's substitution of "application" for my "specification" hopefully has no effect.

2) Applicant has kept careful track of the claims and their numbering.

Enclosed Exhibit A shows that all 31 claims were sent to the examiner with applicant's response filed 22 June 98. There are now no other claims.

*↑ (dated 6-15-98)*

Applicant encloses all 31 claims - exactly the same, with this response. I make no other claims.

*Paragraph 11.1 thru 11.31; pages C-1 thru C-27.*

Enclosed Exhibit B is an updated copy of the Table I sent with my response filed 22 June 98. All 31 claims are listed on one page, together with their Genus and Species, type of claim, amended 6-17-98 note, etc. The left hand column labeled "Examiner" goes back to the old restriction problem, so I have deleted this. The remaining right hand columns under "Applicant", from claim # to the right, are current. Applicant does not now make any other claim.

Applicant requests that the present numbering - claim 1 through claim 31 - be continued. There are no other claims.